

Application No.: 09/867,813

Docket No.: 29785/10000

REMARKS

Claims 10, 12, 13, 16, 19-21, 27, 29, 32, 37, 40, 41, and 44-47 have been rejected under 35 U.S.C. 102(b) as being anticipated by EP 0846611 A2 to Lan ("EP '611").

EP '611 discloses a composition of smectite clays intercalated with both (1) an organic surface modifier and (2) an active material to be delivered to the body in cosmetic and/or pharmaceutical carriers. *See* EP '611 at page 6, lines 11-45.

Independent claims 10, 27, 32, 33, 37, 44, 46, and 48 were previously amended to require that the claimed compositions be "intercalated with an intercalant *consisting essentially of* an organic surface modifier..." (emphasis added). The MPEP indicates that "the transitional phrase '*consisting essentially of*' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the *basic and novel* characteristic(s)' of the claimed invention." MPEP § 2111.03, *quoting In re Herz*, 537 F.2d 549, 551-52, 190 U.S.P.Q. 461, 463 (C.C.P.A. 1976) (emphasis in original).

Independent claims 10, 27, 32, 33, 37, 44, 46, and 48 are not open to the inclusion of additional active ingredients, because such an addition would "materially affect the basic and novel characteristic" of the claimed compositions. The "basic and novel characteristics" of an invention may be indicated by the specification and/or claims. MPEP § 2111.03. In this case, the novel characteristic of the invention is that of an "allergen sorbent composition," as recited in the independent claims. If these claims were open to the inclusion of active ingredients, the novelty of the invention would be materially altered from the *absorption* of a chemical from the body to the *delivery* of a chemical to the body.

Additionally, the prior art method of using a co-intercalated composition of organic surface modifier and active ingredients would not inherently deactivate an allergen and reduce the allergic reaction once applied. In contrast to the prior art composition, "the resulting structure [of the present invention] is very open (significantly more spacing between adjacent inner clay platelet surfaces) and can sorb and retain substantially more urushiol [the allergen]." *See* page 12, lines 16-18 of the specification. In the prior art composition, the interstitial volume (that would otherwise provide the capacity to absorb an allergen) created by the organic surface modifier is occupied by the active ingredient to be delivered. *See* EP '611 at page 6, lines 11-13 and 39-42. Thus, a prior art composition applied to the skin does not inherently absorb allergens.

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Moreover, independent claims 10, 27, 32, 33, 37, 44, 46, and 48 are not obvious under 35 U.S.C. 103(a) over EP '611. EP '611 makes no mention of allergens, and therefore does not provide any motivation or suggestion to one skilled in the art to remove the active material to be delivered in order to enable to absorption of allergens. Additionally, removal of the active material from the disclosed compositions of EP '611 would render the disclosed compositions ineffective for their intended purpose, namely the delivery of the active material to the body. In such an instance, an obviousness rejection cannot be maintained. MPEP § 2143.01. Because these independent claims are not obvious, neither are claims depending therefrom.

It is submitted that rejected claims 9-13, 15-22, 27-33, 37-41, and 44-49 clearly distinguish over the Lan et al. European '661 patent.

Accordingly, it is submitted that all claims are now of proper form and scope for allowance. Early and favorable consideration is respectfully requested.

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Respectfully submitted,

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